

REMARKS

Status of the Claims.

Claims 21, 22, 24, 25, 26, 28, 41, and 45 are pending with entry of this amendment, claims 1-20, 23, 27, 29-40, 42-44, and 46-50 being cancelled and no claims being added. Claims 21 and 45 are amended herein. These amendments introduce no new matter, and merely alter claim dependency reflecting previous claim cancellations.

Claim objections.

Claims 28 and 45 were objected to because they depend on the now canceled claim 29. Claims 28 and 45 are amended herein to remove reference to the deleted claims, thereby obviating this objection.

Claim 45 was objected to under 35 C.F.R. §1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claims. Claims 45, as amended herein refers to claims 21, 22, 24, 25, 26, none of which are multiply dependent. Accordingly, this objection is obviated.

35 U.S.C. §102.

Claims 21-22, 24-28, 41, and 45-47 were rejected under 35 U.S.C. §102(a) as allegedly anticipated by Schier (1995) *et al. Immunotechnology*, 1: 73-81. It is noted that Schier *et al.* appears to have been published in May 1995.

The present application claims priority to June 14, 1995 (see first paragraph of application as filed), less than 1 year prior to Applicants filing date.

Accordingly, Applicants will provide herewith a Declaration in accordance with *In re Katz*, signed by an inventor of the present application, establishing that the Schier *et al.* article describes Applicants' own work and thereby obviate this reference.

In view of this, the rejection under 35 U.S.C. §102(a) should be withdrawn.

35 U.S.C. §112, First Paragraph.

Claims 21, 22, 24, 25, 28, and 45 were rejected under 35 U.S.C. §112, first paragraph, as allegedly not enabled. In particular, the Examiner alleged that the specification does not provide enablement for a nucleic acid encoding a human C6 antibody that comprises the VH chain of C6.5 or the VL chain or C6.5. In particular, it appears the Examiner views the claims as reading on an antibody comprising only a VH or a VL. The Examiner further asserts that the formation of an intact antigen-binding site requires the association of the complete heavy and light chain variable regions of a given antibody. Applicants traverse by amendment and argument.

Claim 1, as amended herein recites:

21. An isolated nucleic acid encoding a human C6 antibody that specifically binds to c-erbB-2, **wherein said C6 antibody comprises a variable heavy (VH) region and a variable light (VL) region**, wherein the variable heavy chain is the variable heavy (V_H) chain of C6.5 (SEQ ID NO. 32) and/or the variable light chain is the variable light (V_L) chain of C6.5 (SEQ ID NO. 36). [emphasis added]

Thus, it is clear that the claim is directed to a nucleic acid comprising **both a VH and a VL** where the VH domain and/or the VL domain is a C6.4 VH or VL domain.

the claim read on a cell within a transgenic animal. To expedite prosecution, claim 28 is amended herein to recite an "isolated cell" thereby obviating this rejection.

Claim 23 was rejected under 35 U.S.C. §112, first paragraph, as allegedly not enabled. Claim 23 is canceled herein thereby obviating this rejection.

Applicants note, however, that these amendments and claim cancellations are made without prejudice and are not to be construed as abandonment of the previously claimed subject matter or agreement with the Examiner's position.

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Should the Examiner seek to maintain the rejections, Applicants request a telephone interview with the Examiner and the Examiner's supervisor.

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If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 267-4161.

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Respectfully submitted,

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